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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,242	04/24/2001	Soren Vindriis	CU-2508RJS	3307

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EXAMINER	
ARNOLD III, TROY G	
ART UNIT	**PAPER NUMBER**
3728	14

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/830,242	VINDRIIS, SOREN	
	Examiner	Art Unit	
	Troy Arnold	3728	

-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3 and 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 2, 3, 8 and 9, the coefficient of friction is claimed to be "between" two surfaces. i.e. the bottom foil and a surface in the bottom of the footwear. Firstly, a coefficient of friction as it is understood by the Examiner, is a non-unitized value comparing the resistance to sliding of a surface compared to a standard surface. Therefore the "between" part of the phrase would appear to be indefinite. In other words, claim 2 should read, "An insole according to claim 1, wherein the bottom foil is equipped with the fabric, and the coefficient of friction of the bottom foil with the fabric is larger than the coefficient of friction without the fabric." For examination purposes, the phrases "and a substantially smooth surface in the a bottom of the footwear" and the phrases similar to it have been given little patentable weight. Secondly, in claim 2, there is no antecedent basis for "the footwear' – the preamble of claim 1 does not positively recite or claim footwear. In claim 7, in the phrase "with respect to the liquid or gel," the antecedent basis for "the gel" is unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The phrase at the end of claim 1 "for reinforcing....creep" is intended use and as such is given little patentable weight. This or similar phrases appear in other claims as well.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutcheson in view of Ogden and Singh. Hutcheson teaches all the limitations of claim 1 except the fabric being at least partially pressed into the plastic foil such that the fabric penetrates below an exterior surface of the foil. (See the embodiment in Fig 11, described in column 5, beginning line 18). Ogden teaches an insole construction in which a portion 46 of a non-woven fabric layer 22 is coated or covered with a liquid barrier layer, which then cools to become solid. See column 12 lines 66-67 and column 13, lines 1-15. Although the molten barrier layer 62 does not penetrate all the way through the non-woven layer 22B, some portion of it, 46, will be coated with the barrier layer 62, which means that it will be partially enclosed in it. Further, in column 13 line 3, Ogden discusses "heat bonding" which implies at least the partial enclosure of one layer in the other, given the relative softness, required thickness and low melting point of the

materials used. Singh teaches impregnating fabric into latex binder material. It would have been obvious in view of Ogden and Singh to one of ordinary skill in the art at the time the invention was made to partially enclose the fabric layers 56 and 58 in the foil layers 12 and 14 of Hutcheson, by melting or partial softening, for the purpose of ensuring that they are better retained against relative movement. Hutcheson as modified regarding claim 1 teaches all the limitations of claim 2 except the coefficient of friction of the bottom foil *with* the fabric being greater than that *without* the fabric. Hutcheson as modified regarding claim 1 teaches all the limitations of claim 3 except the coefficient of friction of the top foil *with* the fabric being lower than that *without* the fabric. Hutcheson teaches the use of a variety of materials for his fabric layers 56, 58. as in column 5, beginning in line 23, and also for his foil layers, in column 5, beginning line 55. It is maintained that it would have been obvious to one of ordinary skill in the art, through routine experimentation, to make the coefficients of the uncovered and covered foils as claimed in claims 2 and 3, for the purpose of design optimization. A certain combination of the materials clearly specified by Hutcheson will meet the limitations claimed in these claims. Hutcheson teaches all the limitations of claim 4 except the fabric having a higher tensile strength than the top foil layer. In view of the various materials suggested by Hutcheson in column 5, lines 43-48, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tensile strength of the fabric material higher than that of the foil layer for the purpose of ensuring that the fabric adequately protected the plastic layer against rupture. This is clearly well within the capability of one of ordinary skill in the art, and is similar to the

argument pertaining to claims 2 and 3 above. Hutcheson teaches all the limitations of claim 5 except the top fabric layer being impregnated with fungicide. Ogden teaches a barrier layer being impregnated with antimicrobial material with fungistatic properties. It would have been obvious in view of Ogden to one of ordinary skill in the art at the time the invention was made to incorporate fungicide into the top material layer of Hutcheson for the purpose of improving the sanitary environment of the foot. See also Hutcheson, column 5, lines 33-37 where he discusses additive substances. Hutcheson teaches all the limitations of claim 6 except heating the foils, pressing the fabric into the foils such that the fabric penetrates below an exterior surface of the foil, and then cooling down the foil. It is maintained that this would have been an obvious method of making the invention of Hutcheson, as modified regarding claim 1, for reasons of ease of assembly or the like. There is nothing unobvious about the procedure claimed. Hutcheson teaches all the limitations of claim 7 except the fabrics being partially enclosed in the foils by heating the foils, pressing the fabrics into the foils, and cooling the foils. Ogden teaches an insole construction in which a portion 46 of a non-woven fabric layer 22 is coated or covered with a liquid barrier layer, which then cools to become solid. See column 12 lines 66-67 and column 13, lines 1-15. Although the molten barrier layer 62 does not penetrate all the way through the non-woven layer 22B, some portion of it, 46, will be coated with the barrier layer 62, which means that it will be partially enclosed in it. Further, in column 13 line 3, Ogden discusses "heat bonding" which implies at least the partial enclosure of one layer in the other, given the relative softness, required thickness and low melting point of the materials used. Singh teaches impregnating fabric into latex

binder material. It would have been obvious in view of Ogden and Singh to one of ordinary skill in the art at the time the invention was made to partially enclose the fabric layers 56 and 58 in the foil layers 12 and 14 of Hutcheson, by melting or partial softening, for the purpose of ensuring that they are better retained against relative movement. Claims 8 and 9 are rejected in the same manner as claims 2 and 3 respectively, above. Hutcheson teaches all the limitations of claim 10 except the woven fabric having a higher tensile strength than the top foil layer, in any direction. In view of the various materials suggested by Hutcheson in column 5, lines 43-48, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tensile strength of the fabric material higher than that of the foil layer for the purpose of ensuring that the fabric adequately protected the plastic layer against rupture. This is clearly well within the capability of one of ordinary skill in the art, and is similar to the argument pertaining to claims 2, 3, 8 and 9 above. Hutcheson teaches all the limitations of claim 11 except the top fabric layer being impregnated with fungicide. Ogden teaches a barrier layer being impregnated with antimicrobial material with fungistatic properties. It would have been obvious in view of Ogden to one of ordinary skill in the art at the time the invention was made to incorporate fungicide into the top fabric layer of Hutcheson for the purpose of improving the sanitary environment of the foot. See also Hutcheson, column 5, lines 33-37 where he discusses additive substances.

Response to Arguments

Applicant's arguments filed 3 December 2003 have been fully considered but they are not persuasive. Regardless of the perceived benefits of the Applicant's invention, the problems it proposes to solve, or the intended usage of the Applicant's invention, it is maintained that Hutcheson, as modified properly by Ogden and Singh (who does in fact teach in the same art as the instant invention), teaches the distinct limitations claimed. Regarding claim 6, it is maintained that the process claimed by the Applicant would have been obvious to one of ordinary skill in the art, when making the insole taught by Hutcheson, as modified. It would have been obvious to one of ordinary skill in the art to look to Ogden and Singh for the suggestion of impregnating fabric into (softened) plastic material, and to modify Hutcheson as such, in order to better the adhesion of the fabric to the foil. Again, the problem the Applicant intends to resolve is not germane to the argument of whether or not the references teach or suggest the claims. (Furthermore it is noted that claim 1, as it was originally written, did not appear to contain both product and method steps which are elaborated on in claim 6, whereas now the claim clearly does.)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-0302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold
Examiner
Art Unit 3728

TGA
1/28/04

Mickey Yu
Supervisory Patent Examiner
Group 3700